

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

As an initial matter, in the Official Action, the Examiner indicates that the Applicants have "determined" that the treatment unit is the electrode, the intermittent output unit is the control circuit and timer, the subject tissue determining unit is the control circuit and the intermittent output setting unit is the control circuit and counter. Applicants respectfully submit that they did not "determine" any such interpretation of the claims for prosecution. Applicants argued that the Examiner failed to set forth a prima facie case for a lack of written description for at least the reasons set forth in the previous Response. Even though the Examiner did not set forth such a prima facie case, Applicants pointed out the support in the specification for the claim terms only "in the interests of advancing prosecution, and by way of example only and not to limit the scope of such claim terms thereto" (see page 4, 2nd paragraph of the response filed on July 5, 2006).

In the Official Action, the Examiner rejects claims 1-4 and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,511,478 to Burnside et al., (hereinafter "Burnside").

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 102(e) for at least the reasons set forth below.

With regard to independent claims 1, 4 and 11, the Examiner argues that Burnside shows all of the features of the claims. In this regard, the Examiner argues that the intermittent output setting means is disclosed in Burnside by the microprocessor (146) and counter (138). Applicants respectfully disagree.

The timer and counter disclosed by Burnside (see column 10, line 22-38) merely operate to turn the power supply off after a desired duration of ablation power is complete. That is, a user sets a desired duration of ablation power using the timer (136). The counter (138) merely counts the elapsed time of ablation power to the tissue and stops when it reaches the set point. If a loss of contact with the tissue is detected by the impedance meter (140) before the set duration has elapsed, the counter stops. **Thus, the counter merely counts the elapsed time that ablation power is applied to the tissue.**

Burnside does not disclose or suggest "setting output values and the number of times of output controlled by the intermittent output control unit based on the determined results of the subject tissue determining unit" as recited in claim 1. Claims 4 and 11 have similar recitations.

With regard to the rejection of claims 1-4 and 11 under 35 U.S.C. § 102(e), an electric surgery apparatus having the features discussed above and as recited in independent claims 1, 4 and 11, is nowhere disclosed in Burnside. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 1, 4 and 11 are not anticipated by Burnside. Accordingly, independent claims 1, 4 and 11 patentably distinguish over Burnside and are allowable. Claims 2 and 3 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-4 and 11 under 35 U.S.C. § 102(b).

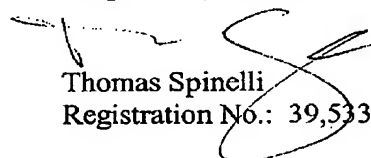
Furthermore, the Applicants respectfully submit that dependent claims 2 and 3 patentably distinguish over Burnside independently of their base claim (1). Specifically, the

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Examiner argues that claims 2 and 3 only recite an intended use and if the prior art structure is capable of performing the intended use, the prior art anticipates the claim. Although Applicants disagree that the device disclosed in Burnside is capable of performing the functions of the subject tissue determining unit recited in claims 2 and 3, in the interests of advancing prosecution, claims 2 and 3 have been amended to recite structural limitations. Specifically, claim 2 has been amended to recite that the "subject tissue determining unit is adapted to determine the subject tissue to be the diameter of blood vessels" while claim 3 has been amended to recite that the "subject tissue determining unit is adapted to determine the subject tissue based on the maximal current value flowing to the subject tissue and the time up to the maximal current value." The amendments to claims 2 and 3 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment to claims 2 and 3.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm